

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



APR 08 2005 In re patent application of: FUKASHIRO, et al.

Serial No.: 09/966,052

Group No.: 2874

Filed: September 28, 2001

Examiner: HEALY, Brian

For: **OPTICAL SWITCHING APPRATUS AND OPTICAL SWITCHING METHOD**

I, Iris C. Rousey, certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

On April 6, 2005

  
Iris C. Rousey

Mail Stop Patent Ext.  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REQUEST FOR RECONSIDERATION ON DECISION FOR APPLICATION**  
**FOR PATENT TERM ADJUSTMENT**  
**UNDER 37 CFR § 1.705(b)**

Reconsideration for an Application for Patent Term Adjustment (PTA) is made herein under 37 CFR § 1.705(b). The original Application was accompanied by the required fee of \$200.00 set forth in 37 CFR § 1.18(e). For reconsideration, no fees are believed necessary, however, if any other fees are required, the Commissioner is authorized to charge Deposit Account No. 50-0462.

**No New Issue Raised From Already Presented In Previously Submitted PTA**

The Application for PTA as filed on July 14, 2004 is hereby incorporated to meet all requirements under 37 CFR § 1.705(b), but is not reiterated in full. No new issue or fact is raised in this reconsideration. The previously submitted Application for PTA has contained all of the facts and the issues of the current request for reconsideration.

**The Original Notice of Non-Compliance Was Erroneously Issued**

In response to the decision of March 18, 2005 on the Application for PTA, the Applicant respectfully request reconsideration for the following reason. The decision fails to address our argument that a Notice of Non-Compliance of July 22, 2003 (the first Notice) was indeed erroneously issued. Although the first Notice required that our original response of July 7, 2003 had to be in the new Amendment format, the new Amendment format was not effective until July 30, 2003, *See* 68 Fed. Reg. 38611; *see also* The Official Gazette Notice of 23 September 2003 (both attached hereto). Since the new Amendment format was not effective until July 30, 2003, our original response of July 7, 2003 did not have to be in the new Amendment format. In fact, it was totally unnecessary for the Applicant to submit a response of July 28, 2003 to the Notice of Non-Compliance of July 22, 2003. Unfortunately, the Applicant was not aware of the effective date of July 30, 2003 for the new Amendment format. The reduction of 21 days for the first Notice and 123 days for a second Notice of Non-Compliance of October 29, 2003 is inapposite for the patent term determination. Thus, the Applicant respectfully submits to the Petitioner Examiner that the patent term reduction by 144 days that are originated from the first Notice should be removed.

**Correct Patent Term Adjustment For This Application Is 192 Days**

The Applicant is entitled to a Patent Term Adjustment of 192 days based upon the following information: The Applicant is entitled to receive an adjustment of 127 days under 37 CFR § 1.703(a)(1). The Applicant's filing date was September 28, 2001, and 14 months from that date was November 28, 2001. Therefore, the Applicant is entitled to an adjustment equal to the time from November 28, 2002 until the first notification issued from the USPTO. The first notification did not occur until April 4, 2003. This is 127 days from November 28, 2002. The Applicant additionally receives another 68 days of Patent Term Adjustment under 37 CFR § 1.703(a)(2). The USPTO received a Response after Non-Final Action on November 28, 2003. The USPTO had 4 months to respond. 4 months after November 28, 2003 is March 28, 2004. The USPTO did not respond to the

Response until a mailing of the Notice of Allowance on June 4, 2004. This is 68 days from March 28, 2004. Applicant also received a 3 days reduction to Patent Term, pursuant to 37 CFR § 1.704(b), for not responding to an April 4, 2003 Office Action within 3 months. However, the Applicant also received an additional reduction, totaling 144 days, to the Patent Term pursuant to 37 CFR § 1.704(c)(7), for submission of a reply having an omission. Applicant submits that the additional reduction of 144 days calculated by the USPTO should be removed. Therefore, the Patent Term Adjustment should be the 195 days minus 3 days for 192 days of Patent Term adjustment.

**No Reduction Could be Assessed Had The Original Response Been Accepted**

The originally submitted response should have been accepted by the USPTO. Because the USPTO erroneously issued the first Notice of Non-Compliance, subsequent events or communications are inapposite to the determination of the patent term adjustment. For the same reason, the Applicant respectfully submits that these subsequent events and communication should be evaluated in favor of the Applicant. In other words, these subsequent events and communications were totally unnecessary had the USPTO correctly accepted the original response.

**Correct Patent Term Adjustment Should Be 192 days**

In summary, Applicant is entitled to have all of the reduction in Patent Term starting from July 7, 2003 removed based on the following reason. The reason for removal is that the initial July 7, 2003 Notice of Non-Compliance was issued in error. The Applicant's initial response of July 7, 2003 should have been accepted since the new amendment format was not effective until July 30, 2003. The Applicant should never have been required to submit another Response, after the initial July 7, 2003 response. The initial July 7, 2003 Response had no omissions. Therefore, the reduction of 144 days to the Patent Term based upon 37 CFR § 1.704(c)(7) should be removed, and a Patent Term Adjustment of 192 days granted. In addition, this Patent should not be subject to a terminal disclaimer.

**Serial No.: 09/966,052**

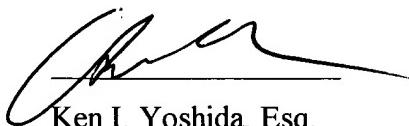
**Page -4-**

**April 6, 2005**

**Conclusion**

In view of the above statements, the Applicant respectfully submits that the corrected total Patent Term Adjustment should be 192 days.

Respectfully submitted,



Ken I. Yoshida, Esq.  
Reg. No. 37,009

Date: April 6, 2005

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Eight Penn Center, Suite 1350  
1628 John F. Kennedy Blvd.  
Philadelphia, PA 19103  
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Enclosures

- 68 Fed. Reg. 38611
- OGN Sept. 23, 2003
- The Application for PTA as filed on July 14, 2004



**RECEIVED BY THE U.S. PATENT AND TRADEMARK OFFICE**

Application for Patent Term Adjustment Under 37 CFR § 1.705(b); and a check in the amount of \$200.00 for filing fees.

Applicant: FUKASHIRO, et al.  
Serial No.: 09/966,052  
Docket No. HITACHI-0025  
Date Sent: July 12, 2004  
KJY:ir

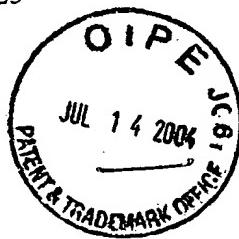
Filed: 9/28/2001

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Date Sent: July 12, 2004  
KJY:ir

Filed: 9/28/2001



DATE July 12, 2004

CHE # 11185

AMOUNT \$200.00

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EXPLANATION Filing Fee Payment (PTA/HITACHI-0025)

CLIENT Hitachi Ltd

HITACHI-0025

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DATE

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K. J. Dwyer

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DATE July 12, 2004

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CLIENT Hitachi Ltd

LAWYER KIY

MATTER HITACHI-0025

US DIVISIONAL TBA FOR OPTICAL SWITCHING APPARATUS /

Filing Fee Payment (PTA/HITACHI-0025)

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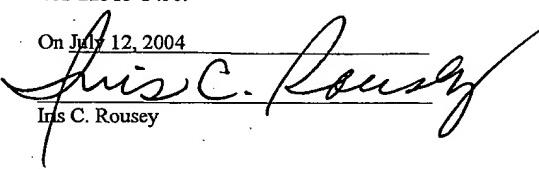
Examiner: HEALY, Brian

For: OPTICAL SWITCHING APPARATUS AND OPTICAL SWITCHING  
METHOD



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On July 12, 2004



*Iris C. Rousey*  
Iris C. Rousey

Mail Stop Patent Ext.  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705(b)**

An Application for Patent Term Adjustment (PTA) is made herein under 37 CFR § 1.705(b). Accompanying the Application is the required fee of \$200.00 set forth in 37 CFR § 1.18(e).

The Applicant respectfully submits that a reduction of 144 days to the Patent Term, under 37 CFR § 1.704(c)(7), for failing to properly respond to a Notice of Non-Compliance, is in error. The Applicant respectfully submits that timely responses were made to the Notices of Non-Compliance, however, the United States Patent and Trademark Office (USPTO) wrongly continued to issue Notices of Non-Compliance. The Applicant has received 127 days of Patent Term Adjustment under 37 CFR § 1.702(a)(1) for the Office's failure to issue a notification 14 months after filing. The Applicant additionally received 68 days of Patent Term Adjustment under 37 CFR § 1.702(a)(2). However, the Applicant has also received a reduction of 3 days to the Patent Term pursuant to 37 CFR § 1.704(b) for not responding to a Non Final Office Action within 3 months. The Applicant further received a total of 144 days reduction to Patent

Term pursuant to 37 CFR § 1.704(c)(7). Because of the currently requested removal of the 144 days from the reduction to Patent Term, the correct Patent Term Adjustment should be 192 days. Alternatively, if 37 CFR § 1.705(c)(2) is deemed to apply in this situation, the Applicant submits that the Patent Term Adjustment should be 138 days.

The Applicant is entitled to a Patent Term Adjustment of 192 days based upon the following information: The Applicant is entitled to receive an adjustment of 127 days under 37 CFR § 1.703(a)(1). The Applicant's filing date was September 28, 2001, and 14 months from that date was November 28, 2001. Therefore, the Applicant is entitled to an adjustment equal to the time from November 28, 2002 until the first notification issued from the USPTO. The first notification did not occur until April 4, 2003. This is 127 days from November 28, 2002. The Applicant additionally receives another 68 days of Patent Term Adjustment under 37 CFR § 1.703(a)(2). The USPTO received a Response after Non-Final Action on November 28, 2003. The USPTO had 4 months to respond. 4 months after November 28, 2003 is March 28, 2004. The USPTO did not respond to the Response until a mailing of the Notice of Allowance on June 4, 2004. This is 68 days from March 28, 2004. Applicant also received a 3 days reduction to Patent Term, pursuant to 37 CFR § 1.704(b), for not responding to an April 4, 2003 Office Action within 3 months. However, the Applicant also received an additional reduction, totaling 144 days, to the Patent Term pursuant to 37 CFR § 1.704(c)(7), for submission of a reply having an omission. Applicant submits that the additional reduction of 144 days calculated by the USPTO should be removed. Therefore, the Patent Term Adjustment should be the 195 days minus 3 days for 192 days of Patent Term adjustment.

Applicant has determined that the reduction to the Patent Term should be removed based upon the following information: The USPTO received a Response after Non-Final on July 7, 2003. On July 7, 2003, the USPTO determined that the Response was Non-Compliant for failing to adhere to the new Amendment format. Therefore, time started to run against the Applicant. However, the Applicant notes that compliance with the new Amendment format was not required until after July 30, 2003. See 68 Fed. Reg. 38611 (attached hereto); also see The Official Gazette Notice of 23 September 2003

(attached hereto). Therefore, Applicant submits that the Amendment of July 7, 2003 was compliant, and that the Notice of Non-Compliance was in error. On July 22, 2003, the Notice of Non-Compliance was mailed. On July 28, 2003, the Office received another Response by the Applicant, making the Amendment compliant with the new Amendment format. On July 28, 2003, it is indicated in the Patent Term Adjustment History, that the USPTO again determined that the Amendment was Non-Compliant and therefore restarted the time running against the Applicant. However, no Notice of Non-Compliance was mailed until October 29, 2003. The Applicant, further notes that the July 28, 2003 Response, is also before July 30, 2003. Therefore, both the July 7, 2003 Response and the July 28, 2003 Response, were both not required to be in the new Amendment format.

Another event occurred that further complicated matters. On July 10, 2003 a Supplemental Response was entered into the File. However, this Supplemental Response was unrelated to the current Application. The USPTO had erroneously matched a different Application listing the same Examiner with the instant Application. Although the serial numbers of the Application were different, the error still occurred. The Examiner did not notice the different Application serial numbers and treated the Supplemental Amendment as if it belonged to the instant Application. The Examiner subsequently issued a Notice of Non-Responsive amendment on October 29, 2003, since the Amendment of July 28, 2003 and the unrelated Supplemental Response of July 10, 2003 did not make sense when read together. Upon receipt of the Notice, the Examiner was contacted and the confusion surrounding the multiple Responses was removed. However, the Examiner stated that the Response had to be in the new Amendment Format. The Applicant again submitted a Response, that was materially the same Amendment as the July 7, 2003 Response, and the USPTO received it on November 28, 2003. This Response was finally accepted and the time running against the Applicant ceased to run.

In conclusion, Applicant is entitled to have all of the reduction in Patent Term starting from July 7, 2003 removed based on two reasons. The first reason for removal is that the initial July 7, 2003 Notice of Non-Compliance was issued in error. The

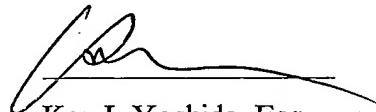
Applicant's initial response of July 7, 2003 should have been accepted since the new amendment format was not effective until July 30, 2003. The second reason for removal is that October 29, 2003 notice was issued based upon an error that had occurred due to the USPTO. There were no conflicting Amendments. The Applicant should never have been required to submit another Response, after the initial July 7, 2003 response. The initial July 7, 2003 Response had no omissions. Therefore, the reduction of 144 days to the Patent Term based upon 37 CFR § 1.704(c)(7) should be removed, and a Patent Term Adjustment of 192 days granted.

This Patent will not be subject to a terminal disclaimer.

Conclusion

In view of the above statements, the Applicant respectfully submits that the corrected total Patent Term Adjustment should be 192 days.

Respectfully submitted,



Ken I. Yoshida, Esq.  
Reg. No. 37,009

Date: July 12, 2004

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Customer No.: 21,302

Enclosure

- 68 Fed. Reg. 38611
- OGN Sept. 23, 2003

No addition

on the supply, distribution, or use of energy. It has not been designated by the Administrator of the Office of Information and Regulatory Affairs as a significant energy action. Therefore, it does not require a Statement of Energy Effects under Executive Order 13211.

#### List of Subjects in 33 CFR Part 165

Harbors, Marine safety, Navigation (water), Reporting and record keeping requirements, Security measures, Waterways.

■ For the reasons set out in the preamble, the Coast Guard amends 33 CFR part 165 as follows:

#### PART 165—REGULATED NAVIGATION AREAS AND LIMITED ACCESS AREAS

■ 1. The authority citation for part 165 continues to read as follows:

**Authority:** 33 U.S.C. 1231; 50 U.S.C. 191; 33 CFR 1.05–1(g), 6.04–1, 6.04–6, and 160.5; Department of Homeland Security Delegation No. 0170.

■ 2. A new temporary § 165.T09–223 is added to read as follows:

##### § 165.T09–223 Safety Zone: Lake Michigan, Chicago, IL.

(a) **Location.** The following area is designated a safety zone: the waters of Lake Michigan within the arc of a circle with a 1000-foot radius with its center in the approximate position of 41°52'07" N, 087°35'65" W. (NAD 1983).

(b) **Effective period.** This section is effective from 9 p.m. (local) until 10 p.m. (local), on July 3, 2003.

(c) **Regulations.** In accordance with the general regulations in § 165.23 of this part, entry into this zone is prohibited unless authorized by the Coast Guard Captain of the Port, Chicago, or the designated Patrol Commander.

Dated: June 12, 2003.

Lynn M. Henderson,  
Commander, U.S. Coast Guard, Acting  
Captain of the Port Chicago.  
[FR Doc. 03–16458 Filed 6–27–03; 8:45 am]  
BILLING CODE 4910–15–U

#### ACTION: Final rule.

**SUMMARY:** The United States Patent and Trademark Office (Office) is revising the rules of practice in patent cases as part of its 21st Century Strategic Plan to implement beginning-to-end electronic image processing of patent applications. Specifically, the changes adopted in this notice facilitate electronic image data capture and processing, streamline the patent application process, and simplify and clarify the pertinent provisions of the rules of practice.

**DATES: Effective Date:** July 30, 2003.

**Applicability date:** The changes apply to any paper filed in the Office on or after July 30, 2003. Further, the revisions to §§ 1.3, 1.14(a) through (d) and (f) through (h), 1.59 and 1.99 apply to all patent applications filed before, on, or after July 30, 2003.

**FOR FURTHER INFORMATION CONTACT:** Jay Lucas (703) 308–6868 or Robert Clarke (703) 305–9177, Senior Legal Advisors, or Robert J. Spar (703) 308–5107, Director, Office of Patent Legal Administration (OPLA), directly by phone. Questions may also be submitted in writing to Mail Stop Comments—Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313–1450; by electronic mail sent to [robert.clarke@uspto.gov](mailto:robert.clarke@uspto.gov); or by facsimile to (703) 872–9411.

**SUPPLEMENTARY INFORMATION:** The Office is increasing the integrity of its internal patent application record maintenance by adopting a new electronic data processing system for the storage and maintenance of all the records associated with patent applications. Because the system is consistent with the data processing system used by the European Patent Office (EPO), it will also improve information exchange among the intellectual property (IP) offices.

The system will use image technology to replace the standard paper processing of patent applications currently used in the Office. The paper components of the patent application file contents (including the specification, oath or declaration, drawings, information disclosure statements, amendments, Office actions, and file jacket notations) of pending applications will be scanned into electronic image files. Thereafter, all processing and examination by all Office personnel will be conducted with the electronic image files, instead of the paper source documents.

The system will affect applicants minimally during the patent application process, because the program affects internal operations and not external communications. Applicants may

continue to send and receive correspondence in paper form, although the Office encourages use of the existing alternative electronic filing system resources for application filings and certain information disclosure statement submissions. The changes to the rules of practice in title 37 of the Code of Federal Regulations (CFR) are designed to improve internal operation by the use of the electronic image format, primarily by easing the requirements upon applicants in amendment practice and information disclosure statement submissions. The electronic nature of patent records will permit their viewing by the public through the Patent Application Information Retrieval (PAIR) system, which has a number of advantages: (1) It provides notice to applicants of certain examination processing activities (e.g., mailing of Office actions); (2) it assures confidence in the integrity of the Office records; (3) it reduces the handling of the records; and (4) it allows parallel processing of the application by various parts of the Office.

The technology and procedures for the new system are similar to those used at the EPO, but adapted to the Office's legal requirements and existing computer systems. The Office announced a prototype program in December of 2002. See *USPTO Announces Prototype of Image Processing*, 1265 Off. Gaz. Pat. Office 87 (Dec. 17, 2002). The Office has incorporated the experience and lessons learned from this prototype program into a production system. See *Notification of United States Patent and Trademark Office Patent Application Records being Stored and Processed in Electronic Form*, 1271 Off. Gaz. Pat. Office 100 (June 17, 2003).

The electronic format of applications will reduce delays in moving information within the Office and between the Office, the applicant, other IP offices and other parties having authority to view the records. It will also reduce the potential for loss of records and misfiling, provide the capacity for multiple parties to access the records simultaneously, improve the efficiency of the publication process, and set the Office up for subsequent improvements in electronic communication related to applications between the Office, the applicant, and other parties.

It is also anticipated that the system will facilitate the sharing of information between the Office and other IP offices. The Office anticipates that agreements to electronically transmit priority documents to certain other IP offices as well as search results and other

#### DEPARTMENT OF COMMERCE

#### Patent and Trademark Office

#### 37 CFR Part 1

[Docket No.: 2003–P–007]

RIN 0651–AB59

#### Changes To Implement Electronic Maintenance of Official Patent Application Records

AGENCY: United States Patent and Trademark Office, Commerce.

## United States Patent and Trademark Office OG Notices: 23 September 2003

### Amendments Permitted under the Revised Amendment Practice and Treatment of Non-Compliant Amendments

#### SUMMARY:

Amendments submitted prior to July 30, 2003 in compliance with the previous version of 37 CFR 1.121 or the revised version promulgated in the Notice of Final Rule Making: Changes To Implement Electronic Maintenance of Official Patent Application Records, 68 Fed. Reg. 38611 (June 30, 2003) (Revised Amendment Practice) will be accepted. Amendments filed on or after July 30, 2003, must be submitted in compliance with revised 37 CFR 1.121. The previously announced limited waivers permitting submission of amendments in the voluntary revised amendment format terminate on July 29, 2003. If a preliminary amendment or a reply under 37 CFR 1.111 filed on or after July 30, 2003 includes one or more non-compliant sections, applicant will be notified via a Notice of Non-Compliant Amendment that the non-compliant section(s) needs to be re-submitted in compliant form within a period set by the Office.

#### BACKGROUND

The United States Patent and Trademark Office (Office) previously announced a prototype program to evaluate the electronic image processing of patent applications using the image file wrapper system (IFW). See USPTO Announces Prototype of Image Processing, 1265 Off. Gaz. Pat. Office 87 (December 17, 2002). The notice included a limited waiver of 37 CFR 1.121 (available in applications being examined in the prototype program) which permitted amendments to be submitted in a voluntary revised amendment format. The limited waiver was later extended to all applications. See Amendments in a Revised Format Now Permitted, 1267 Off. Gaz. Pat. Office 106 (February 25, 2003). The Office revised its rules of practice to implement image file wrapper processing, including the Revised Amendment Practice, taking into account public comments, in the above-noted notice of final rule making, which is effective on July 30, 2003. Many members of the public have requested that the Office permit amendments to be submitted in compliance with the revised version of 37 CFR 1.121 before the effective date of July 30, 2003 in order to provide for a smoother transition to the new practice. This Notice adopts the suggestion.

#### WAIVER OF 37 CFR 1.121 UNTIL JULY 29, 2003

The provisions of 37 CFR 1.121(a), (b), (c) and (d) are hereby waived for amendments to the claims, specification, and drawings, filed before July 30, 2003 in all applications where the amendments comply with 37 CFR 1.121 effective on July 30, 2003. Note: The revised amendment rules (and this waiver) do not apply to 37 CFR 1.121(h) and (i) which indicate that amendments to reissue applications and reexamination proceedings are governed by 37 CFR 1.173 and 37 CFR 1.530(d)-(k), respectively.

#### TREATMENT OF NON-COMPLIANT AMENDMENTS

All amendments received by the Office on or after July 30, 2003 must be in compliance with the rules as required by the Revised Amendment Practice. This practice requires the submission of an amendment document that includes separate sections for amendments to